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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/033,959

12/27/2001

Michael A. Epstein

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06/06/2006

PHILIPS INTELLECTUAL PROPERTY & STANDARDS

P.O. BOX 3001

BRIARCLIFF MANOR, NY 10510

EXAMINER

SCHUBERT, KEVIN R

ART UNIT

PAPER NUMBER

2137

DATE MAILED: 06/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|--------------------------------|--|
| Office Action Summary | Application No. 10/033,959 | Applicant(s) EPSTEIN ET AL. | |
| | Examiner Kevin Schubert | Art Unit 2137 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 22-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 22-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claims 1-13 and 22-35 have been considered.

Continued Examination Under 37 CFR 1.114

5 A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/17/06 has been entered.

10

Specification

The specification is objected to in accordance with the 35 U.S.C. 112 first paragraph enablement rejection.

15

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

20

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

25

Claims 1-13 and 22-35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

30

More specifically, the claims are directed to a method for preventing copying of video images (claim 1) and an apparatus for preventing copying of video images (claim 22) in which a plurality of colored light beams are projected on a screen concurrently with images. The prevention of copying video images appears to be accomplished by projecting colored light beams with the images at a certain time

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so that the projected light beams are not visible to a viewer in a theatre but are visible when recorded on a recording device. As noted by Applicant for support of enablement (see Remarks submitted 1/9/06), the Specification teaches the following: "The period of time is selected such that the bars of colored light are not visible in the video screen images by a viewer, but are visible when recorded on a recording device" [0021]. However, neither the previous statement nor the remainder of Applicant's Specification conveys adequate detail for one of ordinary skill in the art to make and/or use the invention.

Simply providing a general statement (such as the above) does not satisfy the enablement requirement for a unique copy prevention method any more than providing a statement such as "parts are combined in a particular manner" satisfies the enablement requirement for a method of constructing an airplane. Appropriate correction or specific reference to the Specification which obviates the above is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8,10,13,22-23,25, and 28-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Chaum, U.S. Patent No. 5,959,717.

As per claims 1 and 22, the applicant describes a method for preventing copying of video images projected onto a screen comprising the following limitations which are met by Chaum:

a) selecting a scanning sequence from a plurality of predetermined scanning sequences (Col 7, lines 31-64);

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b) projecting a plurality of colored light beams onto the screen concurrently with the images, in accordance with the selected scanning sequence, for a finite period of time (Col 7, lines 31-64);

c) repeating steps a) and b) at least one time (Col 7, lines 31-64).

5 As per claims 2-5, the applicant describes the method of claim 1, which is met by Chaum, with the following limitation which is also met by Chaum:

Wherein at least one of the scanning sequences in step a) includes scrolling the plurality of colored light beams (Col 8, lines 51-54).

10 As per claim 6, the applicant describes the method of claim 1, which is met by Chaum, with the following limitation which is also met by Chaum:

Wherein at least one of the scanning sequences in step a) includes flashing the plurality of colored light beams (Col 7, lines 31-64).

15 As per claims 7,8, and 25, the applicant describes the method of claims 1 and 22, which are met by Chaum, with the following limitation which is also met by Chaum:

Wherein the step c) is performed when a predetermined event occurs (Col 7, lines 31-64).

20 As per claims 10 and 23, the applicant describes the method of claims 1 and 22, which are met by Chaum, with the following limitation which is also met by Chaum:

Wherein the selecting step is performed randomly (Col 7, lines 55-58).

As per claim 13, the applicant describes the method of claim 8, which is met by Chaum, with the following limitation which is also met by Chaum:

25 Wherein the predetermined event includes at least one of a predetermined level of a known color, a known image, a known period of time, and a mark selectively placed in the images (Col 6, lines 59-63).

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As per claim 28, the applicant describes the apparatus of claim 22, which is met by Chaum, with the following limitation which is also met by Chaum:

Wherein the light source includes a plurality of light-emitting diodes, wherein at least two of the light-emitting diodes produce two different colors (Col 7, lines 31-64).

5

As per claims 29-30 and 32-34, the applicant describes the method of claims 1 and 22, which are met by Chaum, with the following limitation which is also met by Chaum:

Wherein the plurality of colored light beams includes a first light beam having a first color, a second light beam having a second color, and a third light beam having a third color, wherein the first, second, and third colors are all different from each other, and wherein none of the light beams overlap with each other (Col 7, line 31 to Col 8, line 56).

10

As per claims 31 and 35, the applicant describes the method of claims 2 and 22, which are met by Chaum, with the following limitation which is also met by Chaum:

Wherein the at least one scanning sequence comprises scrolling separate red, green, and blue color bars scanning across the screen (Col 7, line 31 to Col 8, line 56).

15

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

20

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

25

Claims 9,11-12, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chaum in view of Munich, U.S. Patent No. 5,182,771.

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As per claims 9, 11-12, and 24, the applicant describes the method of claims 8, 1, and 22, which are met by Chaum, with the following limitation which is met by Munich:

Wherein the predetermined event includes an aspect of the content in the image, the content of the image determining when a mark is to be placed in the images (Munich: Col 11, lines 3-15; Col 12, lines 60-68);

Chaum discloses all the limitations of claims 8 and 22. However, Chaum does not disclose that image content can be used to determine when a mark or alert is to be placed in the images. Munich discloses a similar copy protection system in which image content such as scene changes are used to trigger a security event. It would have been obvious to one of ordinary skill in the art at the time the invention was filed to combine the ideas of Munich with those of Chaum because presenting an alert at notable times during a movie, such as scene changes, is another way to annoy a user of an illegally copied movie.

Claims 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chaum in view of Mead, U.S. Patent No. 5,680,454.

As per claims 26-27, the applicant describes the apparatus of claim 22, which is met by Chaum, with the following limitation which is met by Mead:

Wherein the processor further causes the light source to project the colored light beams onto the screen in accordance with a randomly selected scanning rate, for a finite period of time (Mead: Col 1, line 44 to Col 2, line 6).

Chaum discloses all the limitations of claim 22. However, Chaum does not disclose the idea of modifying the scanning rate. Mead discloses a similar copy prevention system in which the scanning rate is randomly altered. It would have been obvious to one of ordinary skill in the art at the time the invention was filed to combine the ideas of Mead with those of Chaum for at least the following two reasons: first modifying the scanning rate prevents a further means to annoy a user watching an illegally copied movie (for example, the alert may flicker) and second randomly modifying the scanning rate makes it more

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difficult for a person making an unauthorized copy of a movie to "break" the system and make a viewable copy of the movie.

Response to Arguments

5 Applicant's arguments, see Remarks, filed 5/17/06, with respect to the 103(a) rejection of Chaum in view of Epstein have been fully considered and are persuasive. Applicant has invoked the 103(c) exclusion principle. Accordingly, the rejection of claims 9, 11-12, and 24 under Chaum in view of Epstein has been withdrawn.

10 Applicant's arguments with respect to the 102(b) rejection of claim 1 under Chaum have been fully considered, but they are not persuasive. More specifically, Applicant presents the following arguments:

1) Chaum teaches that a video projector (12) only projects a single multicolored beam, not a *plurality* of beams

15 2) no teaching of a plurality of predetermined scanning sequences

Examiner respectfully, but most strenuously, disagrees with the above. Regarding 1), Examiner respectfully submits that it was never indicated that the only source for a plurality of colored light beams onto the screen is the video projector (12). Thus, even if true, Applicant's allegation would not properly
20 overcome the rejection.

Assuming *arguendo* that the video projector (12) were the only source for colored light beams, Applicant's allegation that the video projector (12) only projects a single multicolored beam, not a plurality of beams amounts to inherently flawed reasoning. The "single" multicolored beam Applicant refers to is not a "single" beam but rather a projection which incorporates different light beams. A standard color
25 projection would include red beams, green beams, and blue beams of light. When the beams are projected onto the screen properly, an appropriate representation is presented onto the screen.

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Regarding 2, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention **without specifically pointing out how the language of the claims patentably distinguishes** them from the references.

5 Applicant's arguments with respect to the 102(b) rejection of claims 23,25, and 28 under Chaum fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention **without specifically pointing out how the language of the claims patentably distinguishes** them from the references.

10 Regarding the 103(a) rejection of claims 9,11-12, and 24 under Chaum in view of Munich, Applicant traverses on the grounds that no motivation was provided. Examiner notes that motivation was provided (see action mailed 2/17/06, page 5 lines 19-22).

15 Regarding the 103(a) rejection of claims 26-27 under Chaum in view of Mead, Applicant traverses on the grounds that no motivation was provided. Examiner notes that motivation was provided (see action mailed 2/17/06, page 7 line 2).

Conclusion

20 This action is made non-final. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Schubert whose telephone number is (571) 272-4239. The examiner can normally be reached on M-F 7:30-6:00.

 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should
5 you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

10 KS


EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER